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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,011	06/15/2000	Tooru Kamibayashi	04329.2320	9094

22852 7590 07/06/2004

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EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 07/06/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,011

Applicant(s)

KAMIBAYASHI ET AL.

Examiner

Monplaisir G Hamilton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-10 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10, 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-14 were pending. The communication filed on 3/26/04 amended Claims 1-3 and 8-10, cancelled Claims 4-5 and 11-12 and added Claims 15-20. Claims 1-3, 6-10 and 13-20 remain for examination.

Allowable Subject Matter

2. The indicated allowability of claims 4-5 and 11-12 is withdrawn in view of the newly discovered reference to Traw et al (US 5,949,877). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6, 8-10, 13 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Traw et al (US 5,949,877).

Referring to Claims 1, 2 and 9:

Traw discloses a storage medium comprising:

a specified storage area on which revocation information is registered, the revocation information being used to determine whether or not use of the storage medium by an electronic device is to be revoked (col 6, lines 45-55); and

a controller which determines whether or not use of the storage medium by an electronic device which attempts to access to the storage medium is to be revoked (col 3, lines 40-45), based on the revocation information registered on the specified storage area and information sent from the electronic device (col 3, lines 30-45; col 6, lines 45-60), wherein the controller sends a key needed for a content exchange to the electronic device when the controller does not determine that use of the storage medium by the electronic device is to be revoked (col 8, lines 30-55), and wherein a content which is encrypted using the key is written on a predetermined storage area of the storage medium by the electronic device (col 8, lines 40-55).

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Referring to Claim 8:

Traw disclose a contents protection method comprising the steps of:
providing a specified storage area on storage medium and registering revocation information on the specified storage area, the revocation information being used to determine whether or not use of the storage medium by an electronic device is to be revoked (col 6, lines 45-55);

determining whether or not use of the storage medium by an electronic device which attempts to access to the storage medium is to be revoked (col 3, lines 40-45), based on the revocation information registered on the specified storage area and information sent from the electronic device (col 3, lines 30-45; col 6, lines 45-60); sending a key needed for a content exchange to the electronic device when it is not determined that use of the storage medium by the electronic device is to be revoked (col 8, lines 30-55); and

writing a content which is encrypted using the key on a predetermined storage area of the storage medium by the electronic device (col 8, lines 20-50).

Referring to Claims 3, 10, 15 and 18:

Traw discloses the limitation of Claims 1, 2, 8 and 9 above. Traw further discloses the controller determines that use of the storage medium by the electronic device should be revoked, a subsequent process is halted (col 8, lines 10-15).

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Referring to Claims 6, 13, 16 and 19:

Traw discloses the limitation of Claims 1, 2, 8 and 9 above. Traw further discloses the specified storage area is a storage area provided on a read-only non-volatile memory (col 12, lines 15-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. aims 7, 14, 17 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Traw et al (US 5,949,877) in view of Glover (US 6,185, 686).

Referring to Claims 7, 14, 17 and 20:

Traw discloses the limitation of Claims 1, 2, 8 and 9 above. Traw does not explicitly disclose "the specified storage area is a storage area which is provided on a rewritable read-only non-volatile memory and can be accessed only by a secret specific procedure."

Glover discloses the specified storage area is a storage area which is provided on a rewritable read-only non-volatile memory and can be accessed only by a secret specific procedure (col 4, lines 10-30; col 11, lines 35-60).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify teachings of Traw such that the storage medium is accessed by a secret procedure. One of ordinary skill in the art would have been motivated to do this because it would provide a mechanism to protect the encryption keys and information (col 4, lines 15-30; col 9, lines 5-35).

Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6189098 issued to Kaliski, Jr., Burton S. Kaliski discloses a protocol for establishing the authenticity of a client to a server in an electronic transaction by encrypting a certificate with a key known only to the client and the server. The trust of the server, if necessary, can be established by a public key protocol. The client generates and sends over a communications channel a message containing at least a part of a certificate encrypted with the server's public key or a secret session key. The server receives and processes the message to recover at least part of the certificate, verifies and accepts it as proof of the client's authenticity.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is (703) 305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monplaisir Hamilton

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